UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,653	09/23/2003	Christophe Carola	MERCK-2753	9118

23599 7590 04/13/2007

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

EXAMINER	
CHONG, YONG SOO	
ART UNIT	PAPER NUMBER
1617	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/667,653	CAROLA ET AL.	
	Examiner	Art Unit	
	Yong S. Chong	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 December 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) *12-17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11 and 18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the Application

In view of the Appeal Brief filed on 12/26/2006, PROSECUTION IS HEREBY REOPENED. All rejections of the previous Office Action have been withdrawn. The following new rejections will now apply.

Claim(s) 1-18 are pending. Claim(s) 12-17 have been withdrawn. Claim(s) 1-11, 18 are examined herein.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim(s) 1-9, 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Rosenbloom (US Patent 6,753,325 B2).

Rosenbloom discloses a method for preventing, reducing, or treating radiation dermatitis by administering a composition comprising a compound that regulates cell differentiation and proliferation, one or more antioxidants, flavonoids, and a pharmaceutical acceptable carrier (abstract). Preferred antioxidants include vitamin C, vitamin E (tocopherol) acetate and luteolin (col. 4, lines 54-58), particularly the flavonoid, 6-hydroxy-luteolin (col. 6, line 17), which can be used in an amount of about 0.02 to about 2 grams per gram of the antioxidant of the composition (col. 7, lines 1-3). The composition may be formulated into a cream, ointment, lotion, paste, jelly (col. 7, lines 21-33) and may contain UV blockers or filters (col. 8, line 26).

It is noted that the limitations regarding cosmetic application, nutritional supplement, and protection of body cells against oxidative stress are given little patentable weight since they are preamble to a composition claim.

It is respectfully pointed out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish from each other. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus, the intended use of a composition claim will be given no patentable weight.

It is further respectfully pointed out that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). See MPEP 2111.02.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in Graham vs John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 10 is rejected under 35 U.S.C. 103(a) as being obvious over Rosenbloom (US Patent 6,753,325 B2) in view of Ley (US Patent 6,265,611 B1).

The instant claims are directed to a composition comprising a compound of formula I, an antioxidant, and a UV filter.

Rosenbloom teach as discussed above, however, fail to disclose the specifically claimed UV filters.

Ley gives the general teaching that 3-(4-methylbenzylidene)-dl-camphor is a UV filter (col. 5, lines 1-11), which is used in an antioxidant composition (abstract).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to use the specific UV filter, 3-(4-methylbenzylidene)-dl-camphor, disclosed by Ley, in the antioxidant composition disclosed by Rosenbloom.

A person of ordinary skill in the art would have been motivated to do this because: (1) Ley gives the general teaching that 3-(4-methylbenzylidene)-dl-camphor is a UV filter and (2) both Rosenbloom and Ley teach the use of UV filters in an antioxidant composition. Therefore, one of ordinary skill in the art would have had a

reasonable expectation of success in formulating an antioxidant composition comprising a compound of formula I, an antioxidant, and a UV filter (3-(4-methylbenzylidene)-dl-camphor) for a method for preventing, reducing, or treating radiation dermatitis.

Claim(s) 11 is rejected under 35 U.S.C. 103(a) as being obvious over Ley (US Patent 6,265,611 B1) in view of Rosenbloom (US Patent 6,753,325 B2).

The instant claims are directed to a food composition comprising a compound of formula I.

Ley discloses an antioxidant composition for use in foods and cosmetics (abstract). Among the components of the antioxidant composition, flavonoids with antioxidant properties such as tocopherols, vitamin E, vitamin C, vitamin A, preservatives, and emulsifiers are present (col. 4, lines 15-49).

Rosenbloom gives the general teaching that the flavonoid, 6-hydroxy-luteolin, possesses antioxidant properties (col. 6, line 17),

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to use the specific antioxidant, 6-hydroxy-luteolin, disclosed by Rosenbloom, in the food composition disclosed by Ley.

A person of ordinary skill in the art would have been motivated to do this because: (1) Ley teaches the use of flavonoids with antioxidant properties in food compositions and (2) Rosenbloom gives the general teaching that the flavonoid, 6-hydroxy-luteolin, possesses antioxidant properties. Therefore, one of ordinary skill in

the art would have had a reasonable expectation of success in formulating food composition comprising 6-hydroxy-luteolin.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YSC

SREENI PADMANABHAN
SUPERVISO